

- 2 -

- REMARKS -

Claims 15-16, 18-19, 21-22, 24-25 and 27 are rejected under 35 U.S.C. 112 second paragraph as being indefinite for falling to have direct support for "marginal edges" and "margin" in the specification. The Applicant respectfully traverses the rejection. It is believed that a person of ordinary skill in the art would readily understand the terms "marginal edges" and "margin" from the claims and no ambiguity is thus created by the terms.

Claims 14-27 are provisionally rejected under 53 U.S.C. 102(e) as being anticipated by O'Brien et al. (2002/0013636). The Applicant hereby submits that the rejection is defective for the following reasons.

As per §706.02(f)(2) of the MPEP:

"If an earlier filed, copending, and unpublished U.S. patent application discloses subject matter which would anticipate the claims in a later filed pending U.S. application which has a different inventive entity, the examiner should determine whether a provisional 35 U.S.C. 102(e) rejection of the later filed application can be made. " (emphasis added)

Given that the present application and the O'Brien application do not have a different inventive entity (the claims are verbatim), this rejection is defective.

Claims 14-27 are rejected under 35 U.S.C. 102(e) as anticipated by Rubbert et al. (6,648,640) or as being obvious over Iiyama et al. (6,835,066). The Applicant respectfully traverses this rejection for the following reasons.

Rubbert et al. describes the use of scanning techniques to create a computer model of the patient dentition for making an orthodontic appliance or a dental prosthesis. However, Rubbert et al. does not teach using automated prototyping equipment, which receives three dimensional digital data, to make from a wax material the pattern of the dental prosthesis to be manufacture. Therefore, Rubbert et al. does not teach all limitations of the present claims and does not anticipate the claims.

- 3 -

Rubbert et al. teaches making a dental prosthesis directly from the model and avoids the intermediate step of making a pattern of the dental prosthesis. However, the claims of the present application are specifically directed to this intermediate step, which is not taught or suggest by the reference. Iiyama et al. fails to teach or suggest this intermediate step.

Therefore, the claims are not obvious in view of the cited references.

In view of the foregoing, the Applicant believes that either an interference should be declared by the Director in accordance with 35 U.S.C 135(b)(2) with US Patent application 2002/0013636 (now issued to US Patent 6,915,178), or a second non-final action should be issued by the Examiner.

With respect to the interference, the Applicant would like to point out that the present application is a divisional of US Patent 6,691,764 filed on September 3, 2002, which claims priority of US Provisional application 60/396720 filed on July 19, 2002, and Canadian patent application 2,356,631 filed on August 31, 2001. The earliest priority date of the present application is less than one year after the date of publication of O'Brien, namely January 31, 2002.

Respectfully submitted,
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